

Application No. 10/679,265
Reply to Office Action of July 26, 2006



Docket No.: A8130.0135/P135

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings includes replacement sheets for FIGS. 1-10.
Reference characters 20 and 90 have been also deleted from FIGS. 1 and 7, respectively.

Attachment: Replacement sheets

REMARKS

Claims 1 and 3-22 are pending in this application. Claims 1, 3, 6 and 14 have been amended. Claim 2 has been canceled and its limitations have been incorporated in amended independent claim 1. No new matter has been introduced and no new issues have been raised.

New formal drawings labeled "Replacement Sheets" are submitted for the Examiner's approval. The formal drawings also do not include reference characters 20 and 90 that were previously present in FIGS. 1 and 7, respectively.

Claims 1 and 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lizardi (U.S. Patent No. 5,944,724). This rejection is respectfully traversed.

The claimed invention relates to a suture storing device. Amended independent claim 1 recites a "suture storing device" comprising "an elongated shaft having a longitudinal axis, a proximal end and a distal end" and "a handle provided at the proximal end." Amended independent claim 1 also recites "a cavity within the handle for storing at least one strand of suture, wherein the cavity is provided with a hatch and a tie-down bar attached to the hatch."

Lizardi relates to a "system for inserting suture anchors" that includes "a suture anchor insertion tool, a suture anchor, a length of suture thread and any needles pre-attached thereto." (Abstract). Lizardi teaches that the suture anchor insertion tool has "a handle, an elongate suture anchor inserting member, a suture thread retaining cap provided on the handle, an internal retaining cavity formed integrally with the handle and a cover member that is selectively positionable so as to enclose the internal cavity." (Abstract).

Lizardi does not anticipate the subject matter of claims 1 and 8-10. Lizardi is silent about a "suture storing device" having "a handle provided at the proximal end" and "a cavity within the handle for storing at least one strand of suture, wherein the cavity is provided with a hatch and a tie-down bar attached to the hatch," as claim 1 recites. Lizardi teaches that "suture thread retaining member 42 includes a cap member 44 and a generally cylindrical base member 46" that "is capable of retaining the suture thread 14." (Col. 5, lines 2-4; 52-53). In this manner, the "amount of tension maintained in the suture thread 14 may be varied by opening the suture retaining member 42, pulling the thread 14 to the desired tension, and closing the suture retaining member 42 over the thread 14 to capture the thread 14 and maintain the desired tension." (Col. 5, lines 2-4; 56-61). Thus, suture thread retaining member 42 of Lizardi is not a suture storing device, but rather is a suture retaining device – i.e., retaining member 42 clamps down on an intermediate portion of suture thread 14 and maintains the desired tension on suture thread 14, which is stored in internal cavity 28 (which has a slidable, not pivotable, cover member 36). In any event, Lizardi does not disclose a hatch with "a tie-down bar attached to the hatch," as recited in amended independent claim 1. For at least these reasons, Lizardi fails to anticipate the subject matter of claims 1 and 8-10, and withdrawal of the rejection of these claims is respectfully requested.

Applicants note that claim 2 was previously rejected in the July 26, 2006 Office Action under 35 U.S.C. § 103(a) as being unpatentable over Lizardi in view of Keane (U.S. Patent Publ. No. 2003/0204195). As noted above, claim 2 is now canceled and its limitations have been incorporated in amended independent claim 1. Applicants submit that the subject matter of amended independent claim 1 (which now incorporates the limitations of canceled claim 2) would not have been obvious over Lizardi and Keane, whether considered alone or in combination.

None of Lizardi and Keane, considered alone or in combination, discloses, teaches or suggests a “suture storing device” having “a cavity within the handle for storing at least one strand of suture, wherein the cavity is provided with a hatch and a tie-down bar attached to the hatch.” As noted above, Lizardi is silent about a “tie-down bar attached to the hatch,” as in the claimed invention.

Keane also does not disclose all limitations of amended independent claim 1. Keane teaches a spool system wherein “spool 1 is a cylinder shaped member, which is capable of rotating around a central axis 5” and wherein “spool 1 has several grooves 2 encircling its surface, for receiving suture thread.” (¶[0023]). Keane also teaches that “[t]here preferably is a separate groove 2 for each end of the suture thread being dispensed” so that “for a spool that dispenses two separate suture threads, there are preferably four grooves 2 for receiving the ends of each of the two suture threads.” (¶[0023]). Keane is silent about “a tie-down bar attached to the hatch,” as in the claimed invention. Keane teaches a novel spool system with a plurality of grooves for receiving suture, and none of the limitations of claim 1.

In the July 26, 2006 Office Action, the Examiner concedes that “Lizardi does not disclose a tie-down bar” but asserts that “Keane et al. disclose a tie-down bar (Figure 3, not labeled; bar that runs through element 1) attached to a hatch (1; since the spool 1 covers an opening 13 in the handle 8).” (Office Action art 5). This assertion is unsupported. First, spool 1 of Keane is not a “hatch” as defined in Merriam-Webster Collegiate Dictionary, 10th Ed. (“an opening in the deck of a ship or in the floor or roof of a building”) and as known to those skilled in the art. No opening is provided in spool 1 of Keane. Second, the non-labeled “bar that runs through element 1” of Keane is not a “tie-down bar,” much less a “tie-down bar attached to the hatch,” as claim 1 recites. The “bar that runs through element 1” of Keane is actually central axis 5 of spool 1 – the suture is retained in the grooves of the spool, and the axis 5 of the spool is

not a tie-down bar – there is no evidence that the grooves even extend to the axis 5. Thus, Keane does not disclose, teach or suggest “a cavity within the handle for storing at least one strand of suture, wherein the cavity is provided with a hatch and a tie-down bar attached to the hatch,” as in the claimed invention.

Claims 3-7 and 11-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lizardi in view of Keane. This rejection is respectfully traversed.

Independent claim 11 recites a “device for housing sutures attached to surgical needles” comprising “an elongated shaft having a longitudinal axis, a proximal end and a distal end” and “a handle provided at the proximal end.” Independent claim 11 also recites “a cavity within the handle for storing at least one strand of suture provided with at least one surgical needle, the cavity being provided with a pivotable hatch and a tie-down bar attached to the pivotable hatch, wherein the pivotable hatch is configured to be integral with the handle when the pivotable hatch is in a closed position.”

Independent claim 19 recites a “method of dispensing a surgical suture” by *inter alia* “providing a suture housing device comprising . . . a handle provided at the proximal end; and a cavity adjacent the handle for storing at least one strand of suture, the cavity being provided with a pivotable hatch and a tie-down bar attached to the pivotable hatch, wherein the pivotable hatch is configured to be integral with the handle when the pivotable hatch is in a closed position, and wherein the surgical suture is coiled around the tie-down bar and through the cannulated elongated shaft when the pivotable hatch is in the closed position.” Independent claim 19 also recites “actuating the pivotable hatch so that the pivotable hatch forms an angle with respect to the longitudinal axis of the elongated shaft” and “deploying the surgical suture from around the tie-down bar.”

The subject matter of claims 3-7 and 11-22 would not have been obvious over Lizardi and Keane. Specifically, the Office Action fails to establish a *prima facie* case of obviousness. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, either in the references themselves or in the knowledge of a person of ordinary skill in the art, to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. See e.g., In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996).

In the present case, not all limitations of claims 3-7 and 11-22 are disclosed, taught or suggested by Lizardi and Keane, whether considered alone or in combination. As noted above, the references fail to disclose, teach or suggest all limitations of amended independent claim 1. Lizardi and Keane also do not disclose, teach or suggest "a cavity within the handle for storing at least one strand of suture provided with at least one surgical needle, the cavity being provided with a pivotable hatch and a tie-down bar attached to the pivotable hatch, wherein the pivotable hatch is configured to be integral with the handle when the pivotable hatch is in a closed position," as claim 11 recites. Lizardi is silent about "a cavity for storing at least one strand of suture provided with at least one surgical needle," or about "a pivotable hatch and a tie-down bar attached to the pivotable hatch, wherein the pivotable hatch is configured to be integral with the handle when the pivotable hatch is in a closed position." Lizardi teaches a "suture thread retaining member 42" including a cap member 44 and a cylindrical base 46 that is configured to retain a suture thread when the suture retaining member 42 is closed, and not the limitations of claim 11. Keane teaches a novel spool 1

that rotates around a central axis and has several grooves for receiving suture thread, and not the limitations of claim 11.

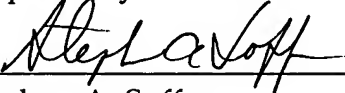
The cited references also do not disclose, teach or suggest all method steps of claim 19. The references are silent about "providing a suture housing device comprising . . . a cavity . . . provided with a pivotable hatch and a tie-down bar attached to the pivotable hatch . . . wherein the surgical suture is coiled around the tie-down bar and through the cannulated elongated shaft when the pivotable hatch is in the closed position," as in the claimed invention. Lizardi and Keane, alone or in combination, also fail to disclose, teach or suggest "actuating the pivotable hatch so that the pivotable hatch forms an angle with respect to the longitudinal axis of the elongated shaft" and "deploying the surgical suture from around the tie-down bar."

For at least these reason, the Office Action fails to establish a *prima facie* case of obviousness, and withdrawal of the rejection of claims 3-7 and 11-22 is respectfully requested.

Allowance of all pending claims is solicited.

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Attachments